

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JIM TAYLOR

Appeal No. 2003-1857
Application No. 09/799,350

ON BRIEF

Before ABRAMS, FRANKFORT and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-11, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to branch-to-wire fasteners used for the lateral training of trellised branches and vines to a support wire or other support structures

(specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art reference in rejecting the appealed claims:

Swick et al. (Swick)	4,655,000	Apr. 7, 1987
----------------------	-----------	--------------

Claims 1-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Swick.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection and answer (Paper Nos. 9 and 12) for the examiner's complete reasoning in support of the rejection and to the brief and reply brief (Paper Nos. 11 and 13) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied Swick patent, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Independent claim 1 recites a fastener comprising a longitudinal flexible member having first and second ends connected to first and second hook portions, wherein the first and second hook portions are "mirror images of each other but rotated 180° such

that said hook portions are oriented in substantially the same direction when secured to the support wire.” The examiner’s statement (final rejection, page 2 and answer, page 3) that Swick is silent on the hook portions being rotated 180° is a mischaracterization. As illustrated in Figures 2 and 3, Swick’s clip portions 14 are not rotated 180° as called for in appellant’s claim 1. In any event, the examiner recognizes that Swick provides no teaching of such orientation of the hook or clip portions but determines that

it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Swick since the modification is merely a change in orientation to provide a tighter loop around the branch thus providing a more secure hold of the branch to the wire and does not present a patentably distinct limitation. The modification to the fastener of Swick performs the same intended function and is merely an alternate equivalent position. The orientation of the hook portions do not affect the function of the hook portions for securing the branch to the support wire. One of ordinary skill in the art would be motivated to modify the orientation since it is old and notoriously well-known to twist a flexible member to reduce the circumference of the securing area to create tighter and better hold. Thus, the modification to Swick is merely an obvious reverse of the orientation without any additional modification to the function of the fastener [answer, pages 3-4].

Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved. In addition, the teaching, motivation, or suggestion may be

implicit from the prior art as a whole, rather than expressly stated in the references.

The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. Broad conclusory statements regarding the teaching of references, standing alone, are not "evidence." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Additionally, rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

In this instance, the examiner has supplied no evidence that the proposed change in orientation of Swick's clip portions would provide a tighter loop or provide a more secure hold of the branch to the wire much less that one of ordinary skill in the art would have recognized this to be the case. From our perspective, the only suggestion for modifying Swick's retainer in the manner proposed by the examiner is found in the

luxury of hindsight accorded one who first viewed the appellant's disclosure. This, of course, is not a proper basis for a rejection. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). It follows that we cannot sustain the rejection of claim 1 or claims 2-11 depending therefrom.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-11 under 35
U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)
)

Appeal No. 2003-1857
Application No. 09/799,350

Page 7

Shlesinger, Arkwright & Garvey LLP
3000 South Eads Street
Arlington, VA 22202